

REMARKS

In the office action mailed February 8, 2005, claims 1-14 and 44-64 were pending. Claims 2-4, 8-10, 48-50, 58 and 59 were withdrawn as being directed to a non-elected species, and claims 1, 5-7, 11-14, 44-47, 51-57 and 60-64 were rejected. In this response, claim 60 has been amended to change its dependency and provide antecedent basis for elements recited therein, and new claims 65-69 are presented herein. Reconsideration of the present application as amended and in view of the remarks that follow is respectfully requested.

The withdrawal of claims 2-4, 8-10, 48-50, 58 and 59 is acknowledged in view of the election of the species of Fig. 1. It is respectfully submitted that claims 8-10, 48-50, 58 and 59 are readable on the elected species as set forth in the restriction requirement, and are entitled to examination in the present application. For example, features recited in claims 8, 48 and 58 are shown in Fig. 3, and features recited in claims 9, 49 and 59 are shown in Fig. 4. Figs. 3 and 4 were not set forth as a species in the previous Restriction Requirement. The application discloses that reduction elements having the features shown in Figs. 3 and 4 can be employed with the elected Species I. *See, e.g.*, page 9, line 20 to page 10, line 8. If claims 8-10, 48-50, 58 and 59 are not entitled to examination in the present application, then it is not clear what species election could have been made to include these claims for examination in the present application. Examination of or clarification of the basis for withdrawal of claims 8-10, 48-50, 58 and 59 in the next communication from the Patent Office is respectfully requested.

Claims 1, 5, 7, 11, 14, 44, 45, 47, 51, 54-56, 61 and 64 were rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,755,797 to Baumgartner. "[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co. Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The claims must not be treated as "mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 1459, 221 USPQ 481, 486

(Fed. Cir. 1984). As a result, a reference that coincidentally lists features of a claim without describing the claimed arrangement, relationship, and organization of such features cannot anticipate.

It is respectfully submitted that Baumgartner does not disclose the claimed arrangement, relationship, and organization of features as recited in the rejected claims. For example, claim 1 is directed to an intravertebral reduction system and recites “a plurality of reduction elements positionable in an intravertebral space adjacent one another in contact with bony tissue, wherein said plurality of reduction elements act one upon the other upon sequential positioning thereof in the intravertebral space thereby compressing cancellous bony tissue and applying an outwardly directed corrective force in the intravertebral space to restore the vertebral body.”

Baumgartner does not disclose any arrangement of reduction elements positionable in an intravertebral space. As stated in the Office Action, Baumgartner discloses an “intervertebral” system. However, there is no disclosure in Baumgartner of an intravertebral reduction system. Rather, Baumgartner discloses that support members are positioned in a central cavity that is created by removing “the material of the nucleus...” of a disk. *See* col. 1, lines 50-54. The disk is positioned between vertebral bodies 1 and include an outer annular region 4 surrounding a central core region, and “in the core region is formed a cavity 5, which was previously created by the removal of the core of the damaged intervertebral disk - or a part thereof - and if necessary damaged parts of the outer annular region 4.” *See* col. 3, lines 32-39. Baumgartner further discloses an “intervertebral prosthesis in the form of an implant consisting of several support members 7, which can be inserted one after the other into the cavity 5 ... as a replacement for at least one part of the core region removed.” *See* col. 3, lines 50-55. Accordingly, since there is no disclosure of reduction elements positionable in an intravertebral space, Baumgartner cannot anticipate claim 1.

Furthermore, there is no disclosure that the support members provide reduction of cavity 5. Baumgartner discloses that support members are packed in cavity 5 “until the cavity is substantially filled by the support members 7 resting against one another and the support members 5 (sic) form a new core region of the intervertebral disk 3 capable of the

transfer of compressive stresses. The number and dimensions of the support members 7 can be varied at random according to the dimension given and the shape of the cavity 5 to be filled....” See col. 3, lines 61-67. There is no disclosure that support members 7 are reduction members. Accordingly, Baumgartner cannot anticipate claim 1 for this additional reason.

Claims 5, 7, 11, and 14 depending from claim 1 distinguish Baumgartner at least for the reasons provided above for claim 1. Accordingly, withdrawal of this basis of the rejection of these claims is respectfully requested.

Claim 44 is directed to an intravertebral reduction system and recites “a plurality of reduction elements positionable in an intravertebral space adjacent one another in contact with bony tissue, wherein said plurality of reduction elements act randomly and radially one upon the other upon sequential positioning thereof in the intravertebral space thereby compressing cancellous bony tissue and applying an outwardly directed corrective force in the intravertebral space to restore the vertebral body.” As discussed above with respect to claim 1, Baumgartner does not disclose reduction elements positionable in an intervertebral space or a plurality of elements that provide reduction of any space. Therefore, Baumgartner cannot anticipate claim 44, and withdrawal of this basis of the rejection is respectfully requested.

Claims 45, 47, 51 and 54 depending from claim 44 distinguish Baumgartner at least for the reasons provided above for claim 44. Accordingly, withdrawal of this basis of the rejection of these claims is respectfully requested.

Claim 55 is directed to an intravertebral reduction system and recites “a plurality of reduction elements positionable in an intravertebral space adjacent one another in contact with bony tissue, wherein said plurality of reduction elements include exterior surface means for facilitating engagement between adjacent reduction elements and for facilitating said reduction elements acting randomly and radially one upon the other upon sequential positioning thereof in the intravertebral space to compress cancellous bony tissue and apply an outwardly directed corrective force in the intravertebral space to restore the vertebral body.” As discussed above with respect to claim 1, Baumgartner does not disclose reduction elements positionable in an intervertebral space or positioning

reduction elements in an intravertebral space. Therefore, Baumgartner cannot anticipate claim 55, and withdrawal of this basis of the rejection is respectfully requested.

Furthermore, claim 55 recites “exterior surface means ... for facilitating said reduction elements acting randomly and radially one upon the other upon sequential positioning thereof in the intravertebral space to compress cancellous bony tissue and apply an outwardly directed corrective force in the intravertebral space to restore the vertebral body.” There is no disclosure in Baumgartner of these functional features recited in claim 55 since Baumgartner only discloses positioning support members in a space between vertebrae. Baumgartner therefore cannot anticipate claim 55 for this additional reason.

Claims 56, 61 and 64 depending from claim 55 distinguish Baumgartner at least for the reasons provided above for claim 55. Accordingly, withdrawal of this basis of the rejection of these claims is respectfully requested.

Claims 6, 46, and 57 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baumgartner. It is respectfully submitted that a prior art reference must suggest the desirability of a modification in order for the propose modification to render a claim obvious. Baumgartner is silent as to the desirability of reduction elements made from PMMA. Since Baumgartner is silent as to these features, it appears that the asserted desirability of the modification suggested in the Office Action is based on the teachings of applicant’s specification, which is not a proper reference. If this is not the case, then citation of a reference that teaches the desirability of modifying Baumgartner to arrive at claims 6, 46 and 57 is respectfully requested. Alternatively, if the rejection is based on facts within the personal knowledge of the Examiner, then an affidavit providing the same is requested so the rejection can be considered and traversed if appropriate.

Claims 12, 13, 52, 53, 60, 62 and 63 were rejected as being unpatentable over Baumgartner in view of U.S. Patent No. 6,620,196 to Trieu. Claims 12 and 13 depend from claim 1, claims 52 and 53 depend from claim 44, and claims 60, 62 and 63 depend from claim 55. Accordingly, claims 12, 13, 52, 53, 60, 62 and 63 are allowable at least because the claim from which each depends is allowable. Furthermore, these claims are independently patentable. Assuming *arguendo* that Trieu were prior art, it is respectfully

submitted that it fails to provide the disclosure missing from Baumgartner regarding an intravertebral reduction system.

New claims 65-67 depend from claim 1, and new claims 68-69 depend from claim 44. An indication of the allowability of new claims 65-69 is hereby solicited in the next communication from the Patent Office.

Reconsideration of the present application including claims 1-14 and 44-69 in view of this response is respectfully requested. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the present application.

Respectfully submitted

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